

ESTTA Tracking number: **ESTTA526195**

Filing date: **03/12/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	NIHC, Inc.
Granted to Date of previous extension	03/13/2013
Address	701 Southwest Broadway, 4th Floor Portland, OR 97205 UNITED STATES
Attorney information	William O. Ferron, Jr. Seed IP Law Group PLLC 701 Fifth Avenue, Suite 5400 Seattle, WA 98104 UNITED STATES billf@seedip.com, litcal@seedip.com Phone:206-622-4900

Applicant Information

Application No	85654856	Publication date	11/13/2012
Opposition Filing Date	03/12/2013	Opposition Period Ends	03/13/2013
Applicant	Tucker, Thomas 9310 NE 97Th Circle Vancouver, WA 98662 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2006/04/01 First Use In Commerce: 2009/04/01
All goods and services in the class are opposed, namely: Clothing for athletic use namely, padded pants, jerseys, board shorts, t-shirts

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1409938	Application Date	01/31/1986
Registration Date	09/16/1986	Foreign Priority Date	NONE
Word Mark	NORDSTROM RACK		
Design Mark			
Description of	NONE		


Mark	
Goods/Services	Class 042. First use: First Use: 1972/10/00 First Use In Commerce: 1972/10/00 RETAIL MEN'S AND WOMEN'S CLOTHING STORE SERVICES

U.S. Registration No.	2980055	Application Date	10/16/2002
Registration Date	07/26/2005	Foreign Priority Date	NONE
Word Mark	NORDSTROM RACK NR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2001/04/00 First Use In Commerce: 2001/04/00 Retail store [and online retail] services, all in the field of apparel, footwear, small leather goods, eyewear, jewelry, and bath, body and personal care products; retail [and online retail] gift shop services		

U.S. Registration No.	3866811	Application Date	02/23/2010
Registration Date	10/26/2010	Foreign Priority Date	NONE
Word Mark	RACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 retail store services and mail order catalog services featuring apparel, footwear, fashion accessories and gifts		

U.S. Registration No.	3962979	Application Date	02/23/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	THE RACK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 retail store services, online retail store services and mail order catalog services featuring apparel, footwear, fashion accessories and gifts

U.S. Registration No.	3893991	Application Date	05/27/2010
Registration Date	12/21/2010	Foreign Priority Date	NONE
Word Mark	NORDSTROM RACK		
Design Mark			
Description of Mark	The mark consists of the word "NORDSTROM" above the word "RACK".		
Goods/Services	Class 035. First use: First Use: 2008/09/25 First Use In Commerce: 2008/09/25 Retail store services featuring apparel, footwear, fashion accessories and gifts		

U.S. Registration No.	3520658	Application Date	03/09/2006
Registration Date	10/21/2008	Foreign Priority Date	NONE
Word Mark	BP.		

Design Mark	BP.
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 girl's and young women's fashion clothing, namely, jackets, turtlenecks, tank tops, dresses, shorts, overalls, blazers, sweaters, cardigans, coats, sweatshirts, vests, skirts, sweatpants, shirts, lingerie, mock turtlenecks, socks, pants and skorts; and women's footwear

U.S. Registration No.	3543681	Application Date	03/09/2006
Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	BP.		
Design Mark	BP.		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 retail store services and online retail store services featuring girl's and young women's fashion clothing, accessories and footwear		

Attachments	78976100#TMSN.gif (1 page)(bytes) 77942725#TMSN.jpeg (1 page)(bytes) 77942736#TMSN.jpeg (1 page)(bytes) 85049432#TMSN.jpeg (1 page)(bytes) 78833726#TMSN.jpeg (1 page)(bytes) 78833729#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (5 pages)(99053 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William O. Ferron, Jr./
Name	William O. Ferron, Jr.
Date	03/12/2013

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NIHC, Inc.,)	
)	Opposition No. _____
Opposer,)	
)	Serial No. 85/654856
v.)	
)	
Thomas Tucker,)	
)	Attorney Docket No. 690097.893
Applicant.)	

Notice of Opposition

NIHC, Inc. ("NIHC"), having an address at 701 Southwest Broadway, Fourth Floor, Portland, Oregon 97205 believes it will be damaged by registration of the mark PBRACK as shown in U.S. Trademark Application Serial No. 85/654856 ("the '856 Application") which was filed June 18, 2012 in class 25 and published for opposition on November 13, 2012. Opposer NIHC therefore opposes this application.

NIHC requested and was granted extensions of time until March 13, 2013 to oppose this application.

The grounds for this Opposition are as follows:

1. Opposer, through its commonly owned and controlled licensee Nordstrom Inc. ("Nordstrom"), operates retail department stores and online retail stores and is engaged in the marketing and sale of a wide variety of apparel, gifts and accessories in interstate commerce.
2. Since at least as early as 1990, Nordstrom adopted and has used the marks RACK, THE RACK and variants thereof ("RACK Marks") in interstate commerce in the United States as trademarks in connection with retail store services featuring apparel, gifts, accessories and other goods.

3. Nordstrom applied for and received US Trademark Registration Nos. 1,409,938, 2,980,055, 3,866,811, 3,962,979, and 3,893,991 for the marks NORDSTROM RACK, NORDSTROM RACK NR and Design, RACK, THE RACK and NORDSTROM RACK (stylized) all of which predate the present application. These registrations have been assigned by Nordstrom to NIHC, which has exclusively licensed the marks shown in the registrations to Nordstrom.

4. Since at least 2009 and before Applicant's adoption of its mark, Nordstrom has used the mark NORDSTROM RACK for clothing, namely shirts.

5. Since commencing use of its RACK Marks as described above, Opposer and its licensee Nordstrom have generated substantial revenue from its retail services and the sale of goods in connection with the marks in the United States. Additionally, Opposer and its licensee Nordstrom have expended substantial sums of money, time and effort in maintaining, advertising, promoting and popularizing its RACK Marks in the United States.

6. As a result of such use of the RACK Marks, and the advertising and promotion of its RACK retail store services and related products sold in connection with those services, Opposer's RACK Marks have become well known in the United States and are recognized as identifying the services and goods of Opposer and its licensee Nordstrom. Thus, its RACK Marks and the associated goodwill are valuable assets of Opposer.

7. Commencing as early as 1985, well prior to the filing date of Applicant's application, Nordstrom adopted and has used the mark BP. and variations of that mark ("the BP Marks") in interstate commerce in the United States as a trademark in connection with the sale of young women's clothing, footwear and accessories and for retail services featuring those products. Nordstrom's BP. goods are sold in its RACK stores.

8. Nordstrom applied for and received US Trademark Registration No. 3520658 for the mark BP. for girls' and young women's fashion clothing, namely, jackets, turtlenecks, tank tops, dresses, shorts, overalls, blazers, sweaters, cardigans, coats, sweatshirts, vests, skirts, sweatpants, shirts, lingerie, mock turtlenecks, socks, pants and skorts; and women's footwear.

The registration has been assigned to NIHC (see reel/frame 4511/0320) and the mark shown in the registration has been exclusively licensed to Nordstrom. The registration is valid and subsisting and has a priority date of March 9, 2006.

9. Nordstrom applied for and received US Trademark Registration No. 3543681 for the mark BP. for retail store services and online retail store services featuring girls' and young women's fashion clothing, accessories and footwear. The registration has been assigned to NIHC (see reel/frame 4511/0320) and the mark shown in the registration has been exclusively licensed to Nordstrom. The registration is valid and subsisting and has a priority date of March 9, 2006.

10. Since commencing use of the BP Marks as described above, Opposer and its licensee Nordstrom have generated substantial revenue from the sale of goods under the BP Marks in the United States. Additionally, Opposer and Nordstrom have expended substantial sums of money, time and effort in advertising, promoting, popularizing and enforcing the BP Marks in the United States.

11. As a result of Opposer's and its licensee Nordstrom's use of the BP Marks, and the advertising and promotion of its BP retail clothing services and clothing and accessories sold in connection with those services, the BP Marks have become well known in the United States and are recognized as identifying the high-quality services and goods of Opposer and its licensee Nordstrom. Thus, the BP Marks and the associated goodwill are valuable assets of Opposer.

12. Applicant has applied to register the PBRACK mark shown in the '856 Application in International Class 25 for "Clothing for athletic use namely, padded pants, jerseys, board shorts, t-shirts."

13. RACK is a dominant portion of Applicant's mark.

14. Applicant's mark PBRACK in Class 25 for the goods described in the '856 Application is confusingly and deceptively similar to Opposer's BP Marks and RACK Marks for its

above-described goods and services, such that the trade and purchasing public will be confused by and deceived into believing that Applicant's goods and services originate with Opposer and its licensee Nordstrom, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Opposer.

15. Upon information and belief, Applicant has not made use of the mark PBRACK in commerce as a trademark in connection with the services listed in the '856 Application or any other goods or services prior to the first use claim of April 1, 2006 of the '856 Application.

16. By reason of the foregoing, Opposer would be greatly damaged by the registration of the mark PBRACK in class 25 to Applicant.

WHEREFORE, Opposer prays that this Opposition be sustained, Applicant's application as to class 25 denied and the mark refused registration.

Correspondence Address

Please direct all communications to:

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DATED this 12th day of March, 2013.

Respectfully submitted,

SEED IP Law Group PLLC



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Attorneys for Opposer NIHC, Inc.

Certificate of Service

I hereby certify that on this 12th day of March, 2013, the foregoing **Notice of Opposition** was served upon Applicant's counsel by United States first-class mail, postage-prepaid, addressed as follows:

Thomas Tucker
9310 NE 97th Circle
Vancouver, WA 98662

/Anne Calico/

Anne Calico

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